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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/533,904 03/21/00 KETTUNEN

A 10-1304

IM22/0818

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EXAMINER

NGUYEN, T

ART UNIT

PAPER NUMBER

1731

4

DATE MAILED:

08/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/533,904

Applicant(s)
KETTUNEN

Examiner
Dean T. Nguyen

Group Art Unit
1731



☒ Responsive to communication(s) filed on Mar 21, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-46 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-21 is/are allowed.

☒ Claim(s) 22-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Oath/Declaration

1. The Oath/Declaration fails to comply with the requirements of 37 CFR 1.175 (a) (1). The Oath/Declaration also fails to comply with the requirements of 37 CFR 1.175 (a) (2).

Statement

2. Applicant fails to submit the Statement under 37 CFR 3.73 (b) with respect to the consent of the assignee (see attached sheet).

Claim Rejections - 35 USC § 112

3. Claims 22-43, 44-46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1) In claims 22, the step of: "supplying a first portion ... and the first cooking zone, "supplying a second portion ... than the first effective alkali concentration-- is not described in the specification. Note that US '414 discloses on Fig. 1, cooking liquor streams 24 (supply source), 134, 27, 30, and 117 (to stream 116). US '856 discloses on Fig. 2, cooking liquor streams 49 (supply source), 38 (equivalent to 134 of US '414), 137 (equivalent to 117 of US '414). There is no teaching of streams 27 and 30 of US '414 in US '856.

2) In claim 22, the step of Treating (Heating) in Zone II of US '856 can not be considered as equivalent to step of Cooking in Zone B of US '414. The treating step of US '856 is

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conducted in the temperature of 120-160°C, preferably 135-145°C, which appears to be below the conventional cooking temperature of 150-170°C, which is shown in the cooking step B of US '414. Note that on Fig. 10, US '856 shown another alternative of the cooking process of Fig. 2 by having 2 pre-treatment stages followed by 2 cooking stages, wherein the effective alkali (EA) of the 2nd cooking zone (CC-COOK) is between 20-30 g/l and the 1st cooking zone (COOKING) is between 25-35 g/l, which is not about 8-120 g/l greater than the EA of the first zone. Therefore, the specification fails to teach the adding the 1st portion of the total amount of cooking liquor to the impregnation zone and the 1st cooking zone and the difference in the EA between the 2 cooking zones as shown above. ✓

3) The teachings of the following dependent claims 25-33, 35, 38-43 are not disclosed in the original specification. The teachings of claims 44-45 are not included in the original specification. ✓

4. Claims 22-46 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not supported by the prior patent is as follows:

1) In claim 22, the step of: "supplying a first portion ... and the first cooking zone, "supplying a second portion ... than the first effective alkali concentration-- is not described in the specification. Note that US '414 discloses on Fig. 1, cooking liquor streams 24 (supply source), 134, 27, 30, and 117 (to stream 116). US '856 discloses on Fig. 2, cooking liquor streams 49

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(supply source), 38 (equivalent to 134 of US '414), 137 (equivalent to 117 of US '414). There is no teaching of streams 27 and 30 of US '414 in US '856.

2) In claim 22, the step of Treating (Heating) in Zone II of US '856 can not be considered as equivalent to step of Cooking in Zone B of US '414. The treating step of US '856 is conducted in the temperature of 120-160°C, preferably 135-145°C, which appears to be below the conventional cooking temperature of 150-170°C, which is shown in the cooking step B of US '414. Note that on Fig. 10, US '856 shown another alternative of the cooking process of Fig. 2 by having 2 pre-treatment stages followed by 2 cooking stages, wherein the effective alkali (EA) of the 2nd cooking zone (CC-COOK) is between 20-30 g/l and the 1st cooking zone (COOKING) is between 25-35 g/l, which is not about 8-120 g/l greater than the EA of the first zone. Therefore, the specification fails to teach the adding the 1st portion of the total amount of cooking liquor to the impregnation zone and the 1st cooking zone and the difference in the EA between the 2 cooking zones as shown above.

3) The teachings of the dependent claims 25-33, 35, 38-43 are not disclosed in the original specification. The teaching of claims 44-45 are not disclosed in the original specification.

Response to Arguments

5. Applicant's comments filed 3/21/00 have been fully considered but they are not persuasive.

Applicant's comment concerning the similarity of the Treating zone II and Cooking zone III on Fig. 2 of US '856 to Cooking zone 1 (B) and 2 (C) is not persuasive in view of the

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discussion above. Furthermore, the teachings of feeding the 1st portion of the cooking liquor to the 1st cooking zone (beside impregnation zone) is not taught in Fig. 2 of US '856.

Applicant's comment concerning the H-Factor issue is not persuasive in view of lack of sufficient objective evidence (calculation sheet) to ensure that the H-Factor of US '414 is taught in US '856. Submission of the calculation for H-Factor is requested.

Allowable Subject Matter

6. Claims 1-21 are allowed since they are the original claims as allowed in the patent.
7. When filing a FAX in Group 1300, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dean T. Nguyen whose telephone no. is (703) 308-2053. The examiner can normally be reached on Monday-Friday @ 7:00-4:00 PM (ET).
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stan Silverman, can be reached on (703) 308-3837. The fax phone number for this group is (703) 305-7718.
Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose tel. No. is (703) 308-0651.

dtn
August 17, 2000


DEAN T. NGUYEN
PRIMARY EXAMINER